REMARKS

Claims 1-10, 12 – 20, and 23 were before the Examiner for consideration. Claims 20 and 23 have been withdrawn from consideration as being directed to a non-elected invention. Claims 1 – 10, 12 – 19, are pending in the application. All pending claims have been rejected.

Applicant appreciates the Examiner's comment that the pending claims would be allowable if amended to overcome the rejections under 35 U.S.C. § 112, 2d paragraph. Applicant's amendments are discussed below.

Summary of Interview on January 27, 2005

Applicant thanks the Examiner for the courtesy and assistance given to Applicant's representative Stephenie Yeung during the telephone interview of January 27, 2005. Applicant also appreciates the Examiner's consideration of the informal submission made on January 25, 2005. During the interview, the Examiner discussed the proposed amendments to the pending claims with Applicant's representative and offered helpful suggestions to overcome the remaining rejections. Applicant's representative agreed to make the amendments, which are reflected above. The Examiner also indicated that the application would be allowable once the amendments were made.

Rejections under 35 U.S.C. § 112, second paragraph

Applicant thanks the Examiner for withdrawing the previous rejections to claims 1-10 and 12 to 19 based on 35 U.S.C. §112, 2d paragraph. However, the Examiner has issued new §112, 2d paragraph rejections against the pending claims on the grounds that they fail to particularly point our and distinctly claim the subject matter which applicant regards as the

invention. Applicant respectfully submits that the foregoing amendments have addressed the Examiner's concerns.

On page 4, paragraph (a) of the Office Action, the Examiner objected to the use of the term "substantially the same" as indefinite and that the specification does not provide a standard for ascertaining the requisite degree. Applicant asserts that one skilled in the art would understand the term to require that the second library to have at least a 95% homology with the first library. However, to advance and expedite the prosecution of this application, Applicant has amended the claims to delete the objected-to term.

Further, in paragraph (b), the Examiner found the screening step (e) of claim 1 with regard to the subjecting step (d) to be unclear. Specifically, the Examiner was unclear whether each individual member of the first initial library is being subjected to each individual restriction enzyme or each "portion" of the first initial library is being subjected to each individual restriction enzyme and thus produce a group of monodigested libraries. In response, Applicant has amended the claim steps to further point out that the first initial library, as a whole, is subjected to parallel digestion by each individual restriction enzyme. The result would be a group of monodigested libraries that correspond to the number of restriction enzymes that was used. The screening step then serves to analyze each resulting monodigested library for the presence of the target fragement. Applicant submits that the Examiner's rejection detailed in paragraphs (b) has been overcome. Withdrawal of the indefiniteness rejection is respectfully requested.

Further, in paragraph (b), the Examiner rejected claims 1, 16 and 18 for indefiniteness because the relationship of the first and second libraries, with respect to the method of isolating a fragment, is unclear. With the amendments noted above, it should be clear

that in Claims 1, 16 and 18, the first initial library and the second initial library share the same composition. Analysis of the first initial library allows the practitioner to arrive at the unique Multiple Enzymatic Characteristic of the target fragment, thereby identifying those restriction enzymes to which the target fragment is insensitive. Digesting the second library with the multitude of restriction enzymes to which the target fragment is insensitive results in a multidigested library which contains the fragment which can then be isolated. Applicant respectfully seeks the withdrawal of the indefiniteness rejection.

In paragraph (d), the Examiner rejected claim 19 as incomplete and indefinite because the resulting product would be one monodigested library and not a series of monodigested libraries. By the foregoing amendment, Applicant has clarified the claim so that it is clear that a group of monodigested libraries is the result of the method of claim 19. Applicant respectfully seeks the withdrawal of the indefiniteness rejection.

Applicant submits that the foregoing amendments have resolved the outstanding issues under §112 and the pending claims are now allowable.

Priority

Applicant acknowledges with appreciation the notice that priority documents under 35 U.S.C. § 119(a) – (d) have been received by the Office.

CONCLUSION

In so far as the above amendments and remarks have addressed fully the Examiner's rejections, the instant application is seen to be in condition for allowance. In view of the foregoing, withdrawal of the Examiner's rejections and issuance of a Notice of Allowance of all pending claims is therefore respectfully requested.

Respectfully submitted,
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